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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/401,595	09/22/1999	KILIAN PETER HOCHREIN	FA/221	4868

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EXAMINER

JUSKA, CHERYL ANN

ART UNIT PAPER NUMBER

1771

DATE MAILED: 10/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/401,595

Applicant(s)

HOCHREIN ET AL.

Examiner

Cheryl Juska

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-12, 15-17, 19 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-12, 15-17, 19, and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Response to Amendment

2. Applicant's amendment filed August 11, 2006, has been entered. Claims 10, 19, and 22 have been amended as requested. Claims 1-9, 13, 14, 18, 20, and 21 are cancelled. Thus, the pending claims are 10-12, 15-17, 19, and 22.

Claim Rejections - 35 USC § 102/103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 10, 11, and 15-17 stand rejected under 35 USC 102(b) as being anticipated by, or in the alternative, under 35 USC 103(a) as being unpatentable over JP 06-047363 issued to Chikamori as set forth in section 3 of the last Office Action.

Applicant has amended independent claim 10 to include the limitation that the oleophobic coating is "oriented to face said biodegradable material," the outer layer is "water-repellent," and

that the “porous polymeric inner layer minimizes the formation of an obstruction layer of liquid forming on or within said cover during aerobic treatment of said biodegradable material.”

However, said amendments are insufficient to overcome the standing rejection.

First, applicant is claiming a cover comprising a laminate material. The preamble limitation that the cover is “for the aerobic treatment of biodegradable material” is merely descriptive of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. It is asserted that the prior art invention meets the chemical and structural limitations of the present claim. As such, it must be presumed that the prior art structure is capable of the same intended use. Applicant has not shown that said prior art invention cannot be used for aerobic treatment of biodegradable material.

Secondly, applicant is claiming a cover and not a laminate covering biodegradable material. In other words, the biodegradable material is not a positive recitation of the claimed invention. Thus, the orientation of the oleophobic coating with respect to the biodegradable material is not given patentable weight. Without a positively claiming the biodegradable material as an element of the invention, the orientation of the coating is non-existent.

Thirdly, Chikamori’s invention is a waterproof sheet of a porous film and an air permeable reinforcement sheet, which may be a fabric or a waterproof paper (section [0005]). As such, it is argued that Chikamori teaches waterproof fabric layer in that the overall product requires waterproof properties and in that an alternative to the fabric layer is a waterproof paper. Hence, one must presume that the fabric of Chikamori is itself waterproof.

Lastly, the limitation that the inner layer minimizes formation of an obstruction layer of liquid formation on or within said cover is not necessarily given patentable weight at this time. Note the minimizing of said formation occurs “*during* aerobic treatment of said biodegradable material.” Once again, applicant is not claiming a method of aerobically treating biodegradable material or a laminate covering biodegradable material, but merely a cover. The minimizing of said formation occurs in a future state that is not part of the presently claimed invention. In the event said limitation is given patentable weight, it is argued that the prior art invention has the same chemical and structural features. As such, the prior art invention must be capable of performing the same functions. Applicant has not shown otherwise. Therefore, the present amendment is insufficient to overcome the standing rejection.

5. Claims 19 and 22 stand rejected under 35 USC 102(b) as being anticipated by, or in the alternative, under 35 USC 103(a) as being unpatentable over JP 06-047363 issued to Chikamori as set forth in sections 4 and 5 of the last Office Action.

Applicant has amended claims 19 and 22 in a manner analogous to claim 10. As such, the above arguments are also applicable here. The rejection of claims 19 and 20 stand.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claim 12 stands rejected under 35 USC 103(a) as being unpatentable over the cited Chikamori reference for the reasons of record.

Response to Arguments

8. Applicant's arguments filed with the amendment have been fully considered but they are not persuasive.

9. Applicant asserts that the Chikamori invention is used to prevent or insulate landfill material from anaerobic decomposition, while the present application is drawn to a cover for the aerobic treatment of biodegradable material (Remarks, page 1, 3rd and 4th paragraphs). In response, applicant has not specifically pointed out how the structure of Chikamori is different. In other words, applicant has not traversed how the Chikamori invention does not read on the present claim limitations. Rather, applicant merely asserts the reference "does not disclose or suggest" the claim invention (Remarks, page 1, 4th paragraph and page 2, 1st paragraph). additionally, the alleged difference in function is merely argumentative of intended use. As argued above, if the structure of Chikamori is equivalent to the presently claimed invention, then it is reasonable to presume that the prior art structure is capable of performing the same function as applicant's invention. Applicant has not provided evidence to the contrary. Therefore, applicant's arguments are found unpersuasive and the above rejections are hereby maintained.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached

at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


CHERYL A. JUSKA
PRIMARY EXAMINER